

Remarks:

Prior to entering the present amendment, claims 1-25 remained pending in the application. In the Office action dated February 22, 2005, claims 1-25 are rejected. In particular:

- Claims 6-8 are rejected under 35 U.S.C. § 112, second paragraph;
- Claims 18, 23 and 25 are rejected under 35 U.S.C. § 102(b) as anticipated by Tadokoro et al.;
- Claims 1 and 12-17 are rejected under 35 U.S.C. § 102(b) as being anticipated by Bruce-Sanders;
- Claims 2-8 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Bruce Sanders in view of Cotter;
- Claims 9-11 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Bruce-Sanders in view of Takayama et al.; and
- Claims 19-22 and 24 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Tadokoro in view of Bruce-Sanders.

Responsive to the Office action, Applicants have cancelled claims 2 and 21, without prejudice, amended claims 1, 18 and 23, and added new claims 26 and 27. In view of the above amendments and the following remarks, Applicants respectfully request reconsideration of the rejected claims.

Rejections under 35 U.S.C. § 112

Claims 6-8 are rejected under 35 U.S.C. § 112, second paragraph. In particular, the examiner suggests that there is insufficient antecedent basis for the claim element "the flexible sheet". Claims 7 and 8 are similarly rejected as they depend from claim 6. Applicants have amended claim 6 to depend from claim 5,

rather than claim 4. Claim 5 recites a presentation system of claim having a writing surface that is "a flexible sheet". Applicants respectfully suggest that, as amended, claim 6 particularly and definitely recites the claimed subject matter, and request the withdrawal of the rejection of claims 6-8 under 35 U.S.C. § 112.

Rejections under 35 U.S.C. § 102

Claims 18, 23 and 25 are rejected under 35 U.S.C. § 102(b) as anticipated by Tadokoro et al. (U.S. Patent No. 4,819,078). Applicants have amended claims 18, 23 and 25.

With respect to claim 18, Applicants have amended the claim to recite a presentation system that includes a printer disposed to print non-permanent ink onto a writing surface. The electronic print board system of Tadokoro et al. includes a drawing sheet that incorporates a photochromic layer. The Tadokoro et al. reference fails to disclose a presentation system that includes a printer disposed to print non-permanent ink onto a writing surface.

With respect to claim 23, Applicants have amended the claim to recite a method that includes sending an image to a presentation system including a printer with a printhead adapted print erasable ink onto a writing surface, and printing the image on the writing surface. The Tadokoro et al. reference fails to disclose a presentation system that includes a printer adapted to print erasable ink onto a writing surface.

In order to anticipate a claim, the cited reference must disclose each and every element of the claim. As Tadokoro et al. fails to disclose each and every element of claims 18 and 23, claims 18 and 23 are not anticipated by Tadokoro et al. As claim 25 depends from claim 23, claim 25 is not anticipated by Tadokoro et al. for

at least these same reasons as claim 23. In view of the above amendments and remarks, Applicants respectfully request the withdrawal of the rejections of claims 18, 23 and 25 under 35 U.S.C. § 102.

Claims 1 and 12-17 are rejected under 35 U.S.C. § 102(b) as being anticipated by Bruce-Sanders (U.S. Patent No. 4,429,478). Applicants have amended claim 1.

Claim 1 as amended, recites a presentation system that includes a printhead that is adapted to move along a traverse rail. The Bruce-Sanders reference fails to disclose a variable information sign that includes a printhead adapted to move along a traverse rail. Claim 1 thus is not anticipated by the Bruce-Sanders reference. Claims 12-17 depend directly or indirectly from claim 1, and thus are not anticipated by Bruce-Sanders for at least the same reasons as claim 1. In view of the above amendments and remarks, Applicants request the withdrawal of the rejections of claims 1 and 12-17 under 35 U.S.C. § 102.

Rejections under 35 U.S.C. § 103

Claims 2-8 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Bruce-Sanders in view of Cotter (U.S. Patent No. 3,873,769). Applicants have cancelled claim 2, and amended claim 1 to include the subject matter of claim 2. The Examiner suggests that it would have been obvious to one of ordinary skill in the art to incorporate one print head moving along a rail instead of multiple stationary print heads. In particular, that it would be easier to control one printhead, and would be less expensive to buy one printhead, as opposed to a plurality of printheads. Applicants traverse the rejection, and suggest the Examiner has failed to establish the *prima facie* obviousness of the rejected claims.

Prima facie obviousness can only be established where there is some suggestion or incentive in the prior art itself to combine or modify the cited references as suggested by the Examiner. The mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art also suggests the desirability of the modification. In this instance, the Examiner has failed to identify any specific suggestion or incentive within the cited references themselves that would motivate one of ordinary skill to modify the references.

In particular, the cited references fail to suggest that it would be less expensive to buy one printhead, as opposed to a plurality of printheads as used by Bruce-Sanders. Additionally, applicants note that the presumed simplicity of having a single printhead may impact the complexity of the accompanying controller.

The Bruce-Sanders controller is described as only tracking the position of the carriage 12 to the right and left, as the vertical position of each printhead is fixed (see for example col. 7, line 50 to col. 8, line 36), and each printhead need only be directed to print pixels in the corresponding horizontal line. In contrast, the controller of Cotter is required to track the position of each pixel in both the X and Y axis, and control a single printhead to apply each pixel in the image. The references, singly or in combination, fail to provide a specific suggestion or motivation to modify the printheads of Bruce-Sanders to use a printhead adapted to move along a traverse rail.

In addition, there can be no suggestion to modify or combine the Bruce-Sanders and Cotter references, as suggested by the Examiner, because such combination would change the principle of operation of the inventions disclosed in

the cited references. Specifically, the Cotter drawing system requires a transparent display surface, as all writing and erasing takes place at the back of the display surface and viewed through the display surface itself. The Bruce-Sanders sign utilizes ink applied to the front of the display surface, and the sign is viewed from the same side. The use of a transparent display surface is incompatible with the use of a continuous roller, as shown in Figs. 8 and 9 of Bruce-Sanders, as the ink applied to the entirety of the roller would be visible through the transparent material.

For at least these reasons, the Examiner has failed to establish the *prima facie* obviousness of the subject matter of claims 1 and 3-8. In view of the above amendments and remarks, Applicants request the withdrawal of the rejection of claims 3-8 under 35 U.S.C. § 103.

Claims 9-11 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Bruce-Sanders in view of Takayama et al. In particular, the Examiner suggests it would have been obvious for one of ordinary skill in the art to scan an image on a presentation board for the reasons stated in column 1 of Takayama, including that the image that was written or printed can now be saved and reprinted by a second printer for printing handouts. Applicants disagree, and traverse the rejection.

Applicants note that amended claim 1, from which claims 9-11 depend, recites a presentation system wherein the printhead is adapted to move along a traverse rail. This feature is neither shown nor suggested by either Bruce-Sanders nor Takayama et al.

Furthermore, Bruce-Sanders and Takayama et al., additionally fail to establish the *prima facie* obviousness of the claimed subject matter, for at least the following reasons.

The disclosure of Takayama et al. fails to provide sufficient motivation to adapt the variable information sign of Bruce-Sanders as suggested by the Examiner, as Bruce-Sanders fails to disclose the manual writing of information on the variable information sign. The print modules of Bruce-Sanders are configured to apply and erase ink applied to the display surface according to instructions from a CPU. In the absence of additional applied information, there can be no suggestion in the Bruce-Sanders reference to scan the display surface, as the information present on the Bruce-Sanders display surface is already present in electronic form in the CPU. The type of information intended to be scanned and captured by the scanner of Takayama et al. is not present in the Bruce-Sanders disclosure.

Similarly, Takayama et al. fails to disclose a printer and printhead adapted to print an image on the writing sheet, and fails to provide a suggestion or motivation for modifying the blackboard of Takayama et al. for providing such a printer. The information present on the blackboard of Takayama et al. is disclosed as manually applied, and there is no suggestion to utilize a printer to apply an image to the blackboard.

There must be some suggestion or motivation in the references themselves to modify the disclosed invention as suggested by the Examiner. The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination (MPEP § 2143.01).

Claims 19-22 and 24 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Tadokoro in view of Bruce-Sanders. In particular, the Examiner suggests that it would have been obvious to one of ordinary skill in the art to provide

the presentation board of Tadokoro with erasable ink, and that the motivation for providing such ink is that ink is a simple, uncomplicated and energy efficient alternative to the high-powered, complicated heat printing system of Tadokoro.

As amended, claim 18 recites a presentation system that includes a printer disposed to print non-permanent ink onto a writing surface, and a scanner adapted to scan the writing surface. Claim 21 has been cancelled. Neither Tadokoro nor Bruce-Sanders, singly or in combination, disclose the recited combination of claim 18. Furthermore, the *prima facie* obviousness of the rejected claims has not been properly established, for at least the following reasons.

The print mechanism of Tadokoro employs a drawing sheet that include a photochromic layer that changes color when illuminated by light-emitting diodes. The displayed image thus prepared can be erased by applying heat to liquefy the photochromic layer (see col. 3, lines 27). Tadokoro therefore already employs an erasable drawing medium, and one that is not subject to accidental erasure by a careless user. The Examiner suggests that a motivation exists for replacing the high-powered, complicated heat printing system of Tadokoro, however no such guidance has been identified in the Tadokoro reference itself, and the printing system of Tadokoro is not identified as deficient or requiring improvement.

Similarly, there is no motivation in the Bruce-Sandors reference to incorporate a scanner adapted to scan a writing surface, in particular because Bruce-Sandors fails to disclose the manual application of additional information to the display surface. In the absence of additional applied material, there is no motivation to capture the image of the display surface. Further, the addition of a scanner would complicate the apparatus of Bruce-Sandors, and would contradict the explicit teaching of the reference itself, which is to provide "a sign which consumes a relatively small amount of electrical energy" and that "includes a minimum number of components and which therefore is relatively inexpensive to construct" (see col. 2, lines 18-31). Modification of the Bruce-Sandors sign as suggested by the Examiner would increase the electrical consumption, the complexity, and the expense of the Bruce-Sandors apparatus, and therefore contradicts the teaching of the reference itself.

The Tadokoro and Bruce-Sandors references fail to render the method of claim 23, as amended, *prima facie* obvious for at least the same reasons as provided for claims 19-22.

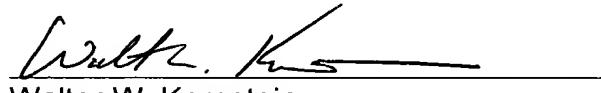
New Claims

Applicants take this opportunity to add new claims 26 and 27, directed to a presentation system and a method for creating an image to be viewed on a presentation system, respectively. Support for the new claims is generally found in the claims as originally filed, and in the specification at page 5, line 23 to page 6, line 4.

Applicants believe that this application is now in condition for allowance, in view of the above amendments and remarks. Accordingly, applicants respectfully request that the Examiner issue a Notice of Allowability covering the pending claims. If the Examiner has any questions, or if a telephone interview would in any way advance prosecution of the application, please contact the undersigned attorney of record.

Respectfully submitted,

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I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Mail Stop Amendment, Commissioner for Patents, P.O. Box 1450, Alexandria, Virginia 22313-1450 on June 17, 2005.



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